



AJ

**TRANSMITTAL OF APPEAL BRIEF**Docket No.  
L0562.70048US00

In re Application of: Michael E. Caporali

Application No. 10/718,362-Conf. #9518	Filing Date November 20, 2003	Examiner M. Hageman	Group Art Unit 3653
---	----------------------------------	------------------------	------------------------

Invention: FLAT MAIL VERTICAL STACKING AID

**TO THE COMMISSIONER OF PATENTS:**

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: September 21, 2007.

The fee for filing this Appeal Brief is \$ 510.00.

Large Entity       Small Entity

A petition for extension of time is also enclosed.

The fee for the extension of time is \_\_\_\_\_.

A check in the amount of \$ 510.00 is enclosed.

Charge the amount of the fee to Deposit Account No. 23/2825.  
This sheet is submitted in duplicate.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any additional fees that may be required or  
credit any overpayment to Deposit Account No. 23/2825.  
This sheet is submitted in duplicate.

Melissa A. Beede  
Attorney Reg. No. : 54,986  
WOLF, GREENFIELD & SACKS, P.C.  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
(617) 646-8000

Dated: October 31, 2007**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 31, 2007

Signature: (Jo-Ann R. Bergantino)



PTO/SB/17 (10-07)  
Approved for use through 06/30/2010. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

**Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**

# **FEE TRANSMITTAL**

## **For FY 2008**

Applicant claims small entity status. See 37 CFR 1.27

<b>TOTAL AMOUNT OF PAYMENT</b>	(\$)	510.00
--------------------------------	------	--------

<b>Complete if Known</b>	
Application Number	10/718,362-Conf. #9518
Filing Date	November 20, 2003
First Named Inventor	Michael E. Caporali
Examiner Name	M. Hageman
Art Unit	3653
Attorney Docket No.	L0562.70048US00

### **METHOD OF PAYMENT (check all that apply)**

<input checked="" type="checkbox"/> Check	<input type="checkbox"/> Credit Card	<input type="checkbox"/> Money Order	<input type="checkbox"/> None	<input type="checkbox"/> Other (please identify): _____
<input type="checkbox"/> Deposit Account	Deposit Account Number:	23/2825		
		Deposit Account Name: Wolf, Greenfield & Sacks, P.C.		

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

<input type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

### **FEE CALCULATION**

#### **1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<b>Application Type</b>	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		<b>Fees Paid (\$)</b>
	<b>Fee (\$)</b>	<b>Small Entity</b>	<b>Fee (\$)</b>	<b>Small Entity</b>	<b>Fee (\$)</b>	<b>Small Entity</b>	
Utility	310	155	510	255	210	105	
Design	210	105	100	50	130	65	
Plant	210	105	310	155	160	80	
Reissue	310	155	510	255	620	310	
Provisional	210	105	0	0	0	0	

#### **2. EXCESS CLAIM FEES**

##### **Fee Description**

Each claim over 20 (including Reissues)

<b>Fee (\$)</b>	<b>Small Entity</b>
-----------------	---------------------

50 25

Each independent claim over 3 (including Reissues)

210 105

Multiple dependent claims

370 185

<b>Total Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- =	x	=	

<b>Multiple Dependent Claims</b>	
<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>

<b>Indep. Claims</b>	<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- =	x	=	

HP = highest number of total claims paid for, if greater than 20.

HP = highest number of independent claims paid for, if greater than 3.

#### **3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$260 (\$130 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 100 =	/50 =	(round up to a whole number) x	=	

#### **4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal

**Fees Paid (\$)**

510.00

<b>SUBMITTED BY</b>				
Signature	<i>Melissa Beede</i>	Registration No. (Attorney/Agent)	54,986	Telephone (617) 646-8000
Name (Print/Type)	Melissa A. Beede	Date	October 31, 2007	

#### **Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 31, 2007

Signature: *Jo-Ann Bergantino* (Jo-Ann R. Bergantino)



Docket No.: L0562.70048US00  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael E. Caporali  
Serial No.: 10/718,362  
Confirmation No.: 9518  
Filed: November 20, 2003  
For: FLAT MAIL VERTICAL STACKING AID  
Examiner: M. Hageman  
Art Unit: 3653

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 10/31/2007

*Jd-Ann Bergantino*  
Jd-Ann R. Bergantino

**APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. §41.37**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This brief, and fee under 37 C.F.R. §41.20(b)(2), are submitted in furtherance of the Notice of Appeal filed on September 21, 2007 in the above-referenced application.

Any additional fees required for consideration of this paper are authorized to be charged to the deposit account 23/2825.

11/05/2007 HUUONG1 00000023 10718362  
01 FC:1402 510.00 OP

1269794.2

**TABLE OF CONTENTS**

I.	Real Party in Interest (37 C.F.R. §41.37(c)(1)(i)).....	3
II.	Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii)) .....	3
III.	Status of Claims (37 C.F.R. §41.37(c)(1)(iii)).....	3
IV.	Status of the Amendments (37 C.F.R. §41.37(c)(1)(iv)) .....	3
V.	Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v)) .....	4
VI.	Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. §41.37(c)(1)(vi)).....	6
VII.	Argument (37 C.F.R. §41.37(c)(1)(vii)) .....	6
A.	Claims 1, 2, 4-10, 12-13 and 15-27 are Patentable over Ashbrook in view of Pippin.....	6
B.	Claims 1-13 and 15-27 are Patentable over Lambert in view of Pippin.....	21
C.	Claims 1-13 and 15-27 are Patentable over Henig in view of Pippin.....	33
VIII.	Conclusion .....	47
IX.	Claims Appendix (37 C.F.R. §41.37(c)(1)(viii)) .....	48
X.	Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix)) .....	52
XI.	Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x)) .....	53

**I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))**

The real party in interest in this application is the assignee, Lockheed Martin Corporation, a Maryland corporation having a place of business at 6801 Rockledge Drive, Bethesda, Maryland 20817.

**II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))**

There are no other appeals or interferences known to the Applicants, the Applicants' legal representative, or the assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))**

There are 26 claims pending in this application, claims 1-13 and 15-27.

A copy of the claims, as pending, is attached as an Appendix. The following list summarizes the status of the claims:

- Claims pending and appealed: 1-13 and 15-27
- Claims rejected: 1-13 and 15-27
- Claims allowed: none
- Claims withdrawn from consideration: none
- Claims canceled: 14.

**IV. Status of the Amendments (37 C.F.R. §41.37(c)(1)(iv))**

No amendments have been filed subsequent to the Final Office Action dated June 20, 2007. The claims as submitted in the Appendix incorporate all prior amendments. No amendments are not entered.

**V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**

The claimed subject matter relates to an insert that is constructed to be disposed within a mail sorting bin. Traditionally, flat mail, such as magazines and newspapers, were stacked horizontally in flat mail trays in order of delivery (i.e., carrier sequence) (page 1, lines 6-7). At each address, the mail carrier would take the top pieces of flat mail from the bin for delivery (page 1, lines 8-9). However, because most pieces of mail do not have the same length and/or width as those of the bin, this system would cause smaller pieces of mail to slide within the bin with respect to other larger pieces after being sorted, and thus fall out of carrier sequence (page 1, lines 9-11). Further, orienting mail horizontally made it difficult for the carrier to read the delivery addresses immediately prior to delivery (page 1, lines 12-14).

Simply orienting mail vertically, however, creates other problems. One drawback associated with stacking mail vertically is that the flat mail tends to slip and/or fall when the mail bin is not full, leading to difficulties for a mail carrier (page 1, lines 16-18). For example, when bins of vertically stacked mail are partially empty, the mail can slide down, resulting in horizontally oriented mail “face up” (i.e., with the address label showing) (page 1, lines 18-20). Alternatively, the mail can pivot with respect to the bin and fall over, resulting in horizontally oriented mail “face down,” with the address label underneath the mail piece (page 1, lines 20-22). Additionally, the top of a piece of less rigid mail (such as a magazine) can curl over itself, thus preventing a mail carrier from observing the delivery address (page 1, lines 22-24). Furthermore, if a piece of mail is curled over itself, its center of gravity may be displaced enough to flip the curled mail over other mail pieces, causing the mail to fall out of carrier sequence (page 1, lines 24-26).

Embodiments of the invention provide a mail bin insert which permits vertical mail stacking in mail bins, and overcomes the aforementioned problems. Independent claim 1 is directed to a mail sorting bin insert 2 that is constructed to be disposed within a mail sorting bin 1 (Fig. 1; page 3, lines 12-14). The bottom 20 of the insert 2 defines a substantially planar surface, and has a length  $l_1$  and a width  $w_1$  that substantially corresponds to at least one of a length and width of the mail sorting bin 1 (Figs. 2-3; page 3, lines 24-29). The insert comprises at least one support 21 projecting upright from the bottom 20 (Figs. 2-3; page 3, lines 14-16). The support 21 is sized and configured to support flat mail 3 in a substantially vertical orientation (Fig. 3; page 3, lines 16-21). Each

support 21 is constructed such that a maximum height  $h$  of the support approximates a maximum height  $h_B$  of the mail sorting bin 1 (Fig. 3; page 5, lines 21-22).

Independent claim 9 is also directed to a mail sorting bin insert 2 that is constructed to be disposed within a mail sorting bin 1 (Fig. 1; page 3, lines 12-14). The insert 2 includes at least one substantially rigid substantially vertical section 21 projecting from a substantially horizontal section 20 (Fig. 3; page 2, lines 7-9). The insert 2 is sized and configured to receive flat mail 3 from an automatic mail sorter, and each substantially vertical section has a height  $h$  of approximately 11 inches when the insert 2 is disposed within the mail sorting bin 1 (Fig. 3; page 2, lines 9-11; page 5, lines 21-27).

Independent claim 19 is likewise directed to a mail sorting bin insert 2 that is constructed to be disposed within a mail sorting bin 1 (Fig. 1; page 3, lines 12-14). The base 20 of the insert 2 defines a substantially planar surface and is sized to substantially cover a bottom surface of the mail sorting bin 1 (Figs. 2-3; page 3, lines 24-29). A plurality of substantially vertical supports 21 are attached to the base 20 (Figs. 2-3; page 3, lines 14-16). Each substantially vertical support 21 has a slope height  $h_S$  and a triangular-shaped cross section sized and configured to support flat mail 3 in a substantially vertical orientation (Fig. 3; page 5, lines 5-6 and 23-26). Each substantially vertical support 21 is also constructed such that a maximum height  $h$  of the support approximates a maximum height  $h_B$  of the mail sorting bin 1 (Fig. 3; page 5, lines 21-22).

Independent claim 20 is again directed to a mail sorting bin insert 2 that is constructed to be disposed within a mail sorting bin 1 (Fig. 1; page 3, lines 12-14). The insert 2 comprises a flat sheet 40 that includes a plurality of sections 41 and a plurality of predefined fold lines 30a, 30b, wherein two adjacent sections 41 are separated by a predefined fold line 30a, 30b (Fig. 4; page 6, lines 14-17). The predefined fold lines 30a, 30b are arranged and configured such that when the flat sheet 40 is folded at the predefined fold lines 30a, 30b and disposed within the mail sorting bin 1, the sheet forms a base 20 and at least one upright support 21 having a height of approximately 11 inches to support flat mail 3 in an upright orientation (Figs. 3-4; page 6, line 17-page 7, line 3).

**VI. Grounds of Rejection to be Reviewed on Appeal (37 C.F.R. §41.37(c)(1)(vi))**

The grounds of rejection to be reviewed on appeal are as follows:

1. The rejection of claims 1, 2, 4-10 and 12-13 and 15-27<sup>1</sup> (including independent claims 1, 9, 19 and 20) under 35 U.S.C. §103(a) as being obvious over Ashbrook (U.S. Patent No. 1,659,509) in view of Pippin (U.S. Patent No. 6,715,614).
2. The rejection of claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) under 35 U.S.C. §103(a) as being obvious over Lambert (U.S. Patent No. 3,908,821) in view of Pippin (U.S. Patent No. 6,715,614).
3. The rejection of claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) under 35 U.S.C. §103(a) as being obvious over Henig (U.S. Patent No. 3,754,646) in view of Pippin (U.S. Patent No. 6,715,614).

**VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**

Applicants respectfully request that the Examiner's final rejection of all of the claims be reversed. The claims are believed to be in allowable condition.

**A. Claims 1, 2, 4-10, 12-13 and 15-27 are Patentable over Ashbrook in view of Pippin**

Claims 1, 2, 4-10, 12-13 and 15-27 (including independent claims 1, 9, 19 and 20) are not unpatentable under 35 U.S.C. §103(a) as being obvious over Ashbrook (U.S. Patent No. 1,659,509) in view of Pippin (U.S. Patent No. 6,715,614).

---

<sup>1</sup> Although claim 14 was also indicated as rejected, claim 14 is canceled.

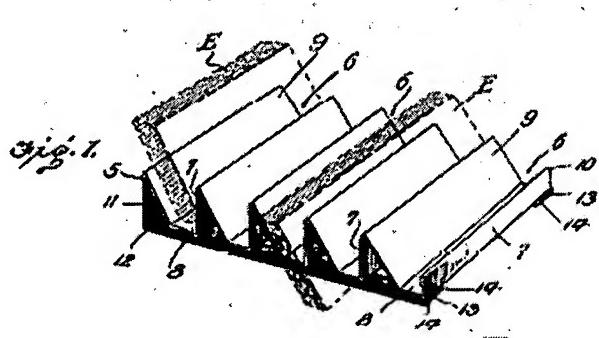
i. Independent claim 1

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin, “wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” or “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

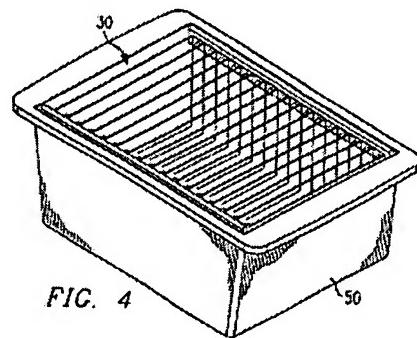
It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Ashbrook with the teachings of Pippin to achieve the claimed invention.

The primary reference, Ashbrook, discloses an envelope holder used by individuals to hold envelopes with a desk drawer (col. 2, lines 62-66). The envelope holder includes a plurality of channel-shaped pockets 6, which have open ends to permit long articles to project out from the pockets (col. 1, lines 25-30). In stark contrast, the primary secondary reference, Pippin, discloses a flats tub 50 used by the U.S. Postal Service (e.g., for mail delivery) (col. 6, lines 9-15). The envelope holder of the primary reference, Ashbrook, and the flats tub 50 of the secondary reference, Pippin, are reproduced below.



**Envelope holder of Ashbrook (Fig. 1)**



**Flats tub 50 of Pippin (Fig. 4)**

As discussed below, there is simply no motivation to use the envelope holder of Ashbrook with the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the envelope holder of Ashbrook to meet the limitations of claim 1 (e.g., “a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” and “at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin”).

1. *The Proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.*

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The Manual of Patent Examining Procedure §2143.01, pg. 2100-140, 8<sup>th</sup> Edition, Revision 6 (2007); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In Gordon, appellants filed a patent application directed to a blood filter assembly used during surgery to filter certain substances from a patient’s blood before returning the blood to the patient’s body. Gordon, 733 F.2d at 901, 221 USPQ at 1126. The sole prior art reference relied upon was a patent to French, which disclosed a liquid strainer for removing dirt and water from gasoline and other light oils. Gordon, 733 F.2d at 901, 221 USPQ at 1127. Both the inlet and outlet of the French device are at the top end of the device and a continuous helical tooth imparts a whirling motion on the incoming liquid, guiding unwanted dirt and water downwardly into a pocket in the bottom of the device. Gordon, 733 F.2d at 901-902, 221 USPQ at 1127. The Board of Patent Appeals found appellants’ claims unpatentable on the theory that it would have been obvious to turn the prior art device upside down. Gordon, 733 F.2d at 902, 221 USPQ at 1127. The Gordon court overturned the finding of obviousness, reasoning that if the prior art device were turned upside down, the device would be rendered inoperable for its intended purpose. Id. Specifically, the court stated that, “French teaches a liquid strainer which relies, at least in part, upon the assistance of

gravity to separate undesired dirt and water from gasoline and other light oils. Therefore, it is not seen that French would have provided motivation to one of ordinary skill in the art to employ the French apparatus in an upside down orientation.” Id.

Similarly, in the present application, the Examiner’s proposed modification to Ashbrook would render the invention of Ashbrook unsatisfactory for its intended purpose. In particular, the Examiner proposes modifying Ashbrook “to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS... for the purposes of maintaining sequence order and facilitating delivery and allowing storage an use of the insert with flats tubs or letter trays.” (Office Action at page 3, lines 4-10)

One purpose of the envelope holder of Ashbrook is to hold envelopes “in such positions that any of them may be readily be grasped and removed” (col. 1, lines 1-6). To accomplish this, the envelope holder includes channel-shaped pockets 6 that are shorter than the height of standard envelopes. Modifying the envelope holder of Ashbrook in the manner suggested in the Office Action would yield a structure that would prohibit envelopes from being readily grasped and removed.

Another purpose of the envelope holder of Ashbrook is “to hold envelopes... within a desk drawer” (col. 2, lines 62-64). To accomplish this, the envelope holder has a length, width and height smaller than the respective length, width and heights of conventional desk drawers. Modifying the envelope holder of Ashbrook in the manner suggested in the Office Action would yield a structure that could not fit within conventional desk drawers.

As in Gordon, where operating the liquid strainer device in an upside down orientation rendered the device inoperable to perform its intended function, modifying the envelope holder of Ashbrook to meet the limitations of claim 1 (e.g., to have “at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” of Pippin, and such that “each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin” of Pippin) would (1) render the envelope holder of Ashbrook unable to be disposed in a conventional desk drawer, and (2) prohibit envelopes held by the envelope holder from being readily grasped and removed, thwarting both the “principle use” and

“aim” of the invention. Indeed, the envelope holder would lose *all practical functionality as an envelope holder*.

Accordingly, because the proposed modification to Ashbrook would render the envelope holder of Ashbrook unsatisfactory for its intended purpose, there is no motivation to make such a modification. Therefore, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed. Claims 2, 4-8, 22 and 24 depend from independent claim 1 and are patentable over Ashbrook and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.*

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The Manual of Patent Examining Procedure §2143.01, pg. 2100-141, 8<sup>th</sup> Edition, Revision 6 (2007); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In *Ratti*, appellant’s claims were directed to an oil seal for insertion in a cylindrical bore, comprising a sealing ring having an outer bore engaging portion formed of resiliently deformable material. *Ratti*, 270 F.2d at 810, 123 USPQ at 350. The primary reference relied upon in a rejection based on a combination of references disclosed a housing provided with a bore surrounding a centrally located shaft. *Ratti*, 270 F.2d at 811, 123 USPQ at 350. A sealing member is press fitted into the space between the bore and the shaft, wherein the bore engaging portion of the sealing member is stiffened by a cylindrical sheet metal casing that acts as a reinforcing member. *Id.* Thus, the primary reference taught that the device required rigidity for operation, whereas the claims required resiliency. *Id.* The court reversed the obviousness rejection holding that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which [the primary reference] construction was designed to operate.” *Ratti*, 270 F.2d at 812, 123 USPQ at 352.

In the present application, the Examiner proposes a modification to Ashbrook that would change the principle of operation of the invention. The Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook... for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.” Thus, the Examiner suggests modifying Ashbrook so that the envelope holder is used for *mail delivery*, a purpose completely unrelated to – and incompatible with – its intended purpose.

Further, the modification suggested by the Examiner requires the type of “substantial reconstruction and redesign” that the Ratti court deemed an improper modification of the primary reference. As discussed above, the Examiner suggests modifying Ashbrook “to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS.” (Office Action at page 3, lines 4-8) The proposed modification entirely changes both the structure and purpose of the invention of Ashbrook. In particular, the proposed modification would result in an envelope holder that would no longer resemble the inventive structure envisioned in Ashbrook, and have none of the functionality originally intended.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. The Manual of Patent Examining Procedure §2144.05, pg. 2100-152, 8th Edition, Revision 6 (2007); *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The Supreme Court of the United States recently confirmed this principle, holding that “when the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *Teleflex Inc. v. KSR Int’l Co.*, 82 USPQ2d at 1395.

Pippin clearly teaches away from the modification proposed by the Examiner. In particular, Pippin teaches a mail case in which mail is sorted into individual bags, each representing a unique

delivery point (e.g., col. 2, lines 23-25). The mail case is described as overcoming “significant problems” with traditional mail cases (col. 1, line 47). The problems described are that “dividers 21 between stops in existing USPS mail cases are relatively rigid, and they cannot be conveniently repositioned during a sort” (col. 1, lines 47-50). Indeed, Pippin states that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Ashbrook is directed to an envelope holder having non-compliant, non-flexible, rigid dividers that cannot be repositioned. Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

ii. Independent Claim 9

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include each substantially

vertical section has [*sic*] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the envelope holder of Ashbrook within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the envelope holder of Ashbrook to meet the limitations of claim 9.

1. *The Proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Ashbrook proposed in connection with claim 9 would render the invention of Ashbrook unsatisfactory for its intended purpose. First, as discussed above, the envelope holder is constructed to hold envelopes “in such positions that any of them may be readily be grasped and removed” (col. 1, lines 1-6). If the “supports” of the envelope holder were reconstructed to have a height of approximately 11 inches, as suggested by the Examiner in accordance with the proposed modification, the height of supports would far exceed the height of the envelopes, such that they could not be readily grasped and removed.

Second, as discussed above, the envelope holder is constructed “to hold envelopes... within a desk drawer” (col. 2, lines 62-64). Modifying the pockets 6 of the envelope holder to have a height of approximately 11 inches render the envelope holder unable to be disposed within conventional desk drawers.

Modifying the pockets 6 of the envelope holder of Ashbrook to have a height of approximately 11 inches would thus prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers. Accordingly, the proposed modification would render the envelope holder of Ashbrook unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is

improper and should be reversed. Claims 10, 12-13, 15-18 and 25 depend from independent claim 9 and are patentable over Ashbrook and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.*

The modification to Ashbrook proposed in connection with claim 9 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the pockets 6 of the envelope holder of Ashbrook, the Examiner proposed using the envelope holder for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

iii. Independent Claim 19

The Office Action concedes that Ashbrook does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin “wherein the base is sized to substantially cover a bottom surface of the mail sorting bin” or “wherein each substantially vertical support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 19. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Ashbrook to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the envelope holder of Ashbrook within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the envelope holder of Ashbrook to meet the limitations of claim 19.

1. *The Proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.*

For the reasons discussed in connection with claim 1, modifying the envelope holder of Ashbrook such that (1) its base is sized to substantially cover the bottom surface of the mail sorting bin of Pippin, and (2) each substantially vertical support is constructed such that the maximum height of the support approximates the maximum height of the mail sorting bin of Pippin, would render the envelope holder unsatisfactory for its intended purpose. In particular, the proposed modification would prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed. Claims 23 and 26 depend from independent claim 19 and are patentable over Ashbrook and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.*

For the reasons discussed in connection with claim 1, modifying the envelope holder of Ashbrook such that (1) its base is sized to substantially cover the bottom surface of the mail sorting bin of Pippin, and (2) each substantially vertical support is constructed such that the maximum height of the support approximates the maximum height of the mail sorting bin of Pippin, would change the principle of operation of the invention.

In addition to proposing significantly re-dimensioning the envelope holder of Ashbrook, the Examiner proposed using the envelope holder of Ashbrook for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

iv. Independent Claim 20

The Office Action concedes that Ashbrook does not disclose “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines... wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines and disposed within the mail sorting bin, the sheet forms a base and at least one upright support having a height of approximately 11 inches to support flat mail in an upright orientation,” as recited in claim 20. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Ashbrook to include the support having a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of fitting closely within existing letter trays use [*sic*] by the USPS.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below. As discussed below, there is simply no motivation to use the envelope holder of Ashbrook within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the envelope holder of Ashbrook to meet the limitations of claim 20.

Further, as discussed below, neither reference teaches "a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines," as recited in claim 20.

1. *The Proposed Modification to Ashbrook Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Ashbrook proposed in connection with claim 20 would render the invention of Ashbrook unsatisfactory for its intended purpose. First, as discussed above, the envelope holder is constructed to hold envelopes "in such positions that any of them may be readily be grasped and removed" (col. 1, lines 1-6). If the "supports" of the envelope holder were reconstructed to have a height of approximately 11 inches, as suggested by the Examiner in accordance with the proposed modification, the height of supports would far exceed the height of the envelopes, such that they could not be readily grasped and removed.

Second, as discussed above, the envelope holder is constructed "to hold envelopes... within a desk drawer" (col. 2, lines 62-64). Modifying the pockets 6 of the envelope holder to have a height of approximately 11 inches render the envelope holder unable to be disposed within conventional desk drawers.

Modifying the pockets 6 of the envelope holder of Ashbrook to have a height of approximately 11 inches would thus prohibit (1) envelopes from being readily grasped and removed, and (2) disposal of the envelope holder in conventional desk drawers. Accordingly, the proposed modification would render the envelope holder of Ashbrook unsatisfactory for its intended

purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed. Claims 21 and 27 depend from independent claim 20 and are patentable over Ashbrook and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Ashbrook Would Change the Principle of Operation of the Invention.*

The modification to Ashbrook proposed in connection with claim 20 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the pockets 6 of the envelope holder of Ashbrook, the Examiner proposed using the envelope holder for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the envelope holder of Ashbrook, as well as a change in the basic principle (i.e., holding envelopes for personal or office use) under which the envelope holder was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Ashbrook with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

4. *Neither reference teaches the recited “flat sheet” including “predefined fold lines.”*

Further, neither reference teaches “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines,” as recited in claim 20.

The Office Action cites Fig. 1, page 1, lines 20+ of Ashbrook as allegedly disclosing this feature. However, Ashbrook is completely respect with respect to any “*flat sheet*” or “*predefined fold lines*.”

If the Examiner believes these features are somehow inherent, he has not met the burden required to establish inherency. As set forth in MPEP § 2112: “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further as set forth in MPEP § 2112, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such technical reasoning has been provided.

Accordingly, for this additional reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

5. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Ashbrook in view of Pippin is improper and should be reversed.

**B. Claims 1-13 and 15-27 are Patentable over Lambert in view of Pippin**

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) are not unpatentable under 35 U.S.C. §103(a) as being obvious over Lambert (U.S. Patent No. 3,908,821) in view of Pippin (U.S. Patent No. 6,715,614).

i. Independent claim 1

The Office Action appears to concede that Lambert does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin, “wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” or “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

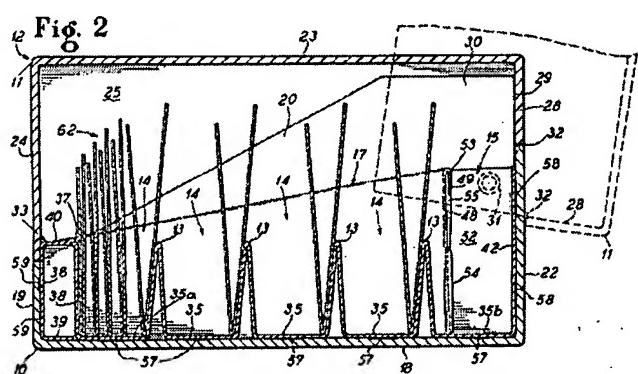
It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

The Office Action provides no motivation whatsoever to modify Lambert such that “at least one of the length and the width substantially corresponds to at least one of a length and width of the

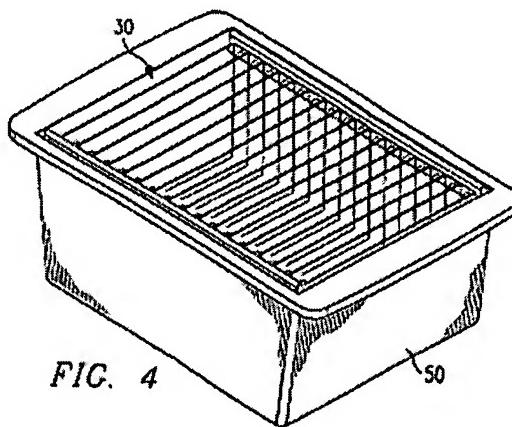
“mail sorting bin” of Pippin. Applicants submit that this is improper. A rational underpinning for a proposed modification must be provided. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007).

Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Lambert with the teachings of Pippin to achieve the claimed invention.

The primary reference, Lambert, discloses a rectangular box 12 (comprising a record keeping tray 10 hinged to a cover 11) having spaced dividers 13 providing upwardly opening pockets 14 to receive cancelled checks (col. 1, line 62 - col. 2, line 3). In stark contrast, the primary secondary reference, Pippin, discloses a flats tub 50 used by the U.S. Postal Service (e.g., for mail delivery) (col. 6, lines 9-15). The record keeping tray 10 of the primary reference, Lambert, and the flats tub 50 of the secondary reference, Pippin, are reproduced below.



### **Record keeping tray of Lambert (Fig. 2)**



### **Flats tub 50 of Pippin (Fig. 4)**

As discussed below, there is simply no motivation to use the record keeping tray of Lambert with the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the record keeping tray of Lambert to meet the limitations of claim 1 (e.g., “a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” and “at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail

in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin").

1. *The Proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.*

As discussed herein, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The Manual of Patent Examining Procedure §2143.01, pg. 2100-140, 8<sup>th</sup> Edition, Revision 6 (2007); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In the present application, the Examiner's proposed modification to Lambert would render the invention of Lambert unsatisfactory for its intended purpose. In particular, the Examiner proposes modifying Lambert "to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin... for the purposes of maintaining sequence order and facilitating delivery." (Office Action at page 9, lines 4-8) The Examiner also apparently proposes modifying Lambert to include "a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin," although no motivation is provided. Nevertheless, it is assumed such a modification is proposed, as Lambert does not disclose or suggest this feature.

The record keeping tray 10 of Lambert is used as a financial organizer that stores canceled checks (col. 1, lines 3-7; col. 2, lines 1-3). In order to maintain canceled checks in a neat and orderly fashion in the pockets 14, the length of the pockets is dimensioned to be substantially the same as the length of the canceled checks to be received in the pockets, but sufficiently oversized for clearance and ease of insertion and removal of the canceled checks on their longitudinal edges (col. 3, lines 56-62). The pockets 14 are supported by spaced dividers 13, which are substantially smaller than the pockets 14. The invention of Lambert is described as providing a useful, convenient, compact, sturdy, attractive and orderly record keeping tray (col. 5, lines 61-63).

Modifying the record keeping tray 10 of Lambert in the manner suggested would result in an unwieldy organizer, completely unsuited for the purpose of organizing canceled checks. Quite the opposite of being a desirable modification, the suggested modification would destroy the objectives of Lambert in achieving a “convenient, compact” record keeping tray. In addition, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions. It is entirely unclear how the record keeping tray 10 could continue to serve its purpose of organizing canceled checks.

As in Gordon, discussed herein, wherein operating the liquid strainer device in an upside down orientation rendered the device inoperable to perform its intended function, modifying the record keeping tray 10 of Lambert to meet the limitations of claim 1 would render the invention of Lambert unable to perform its intended functions of convenient and compact record keeping for canceled checks. Indeed, the record keeping tray 10 would lose all practical functionality as an organizing tool for canceled checks.

Accordingly, because the proposed modification to Lambert would render the record keeping tray 10 of Lambert unsatisfactory for its intended purpose, there is no motivation to make such a modification. Therefore, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed. Claims 1-8, 22 and 24 depend from independent claim 1 and are patentable over Lambert and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.*

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The Manual of Patent Examining Procedure §2143.01, pg. 2100-141, 8<sup>th</sup> Edition, Revision 6 (2007); In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the present application, the Examiner proposes a modification to Lambert that would change the principle of operation of the invention. The Examiner states “[i]t would have been

obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Lambert... for the purposes of maintaining sequence order and facilitating delivery." Thus, the Examiner suggests modifying Lambert so that the dividers 13 are used (in connection with the flats tub of Pippin) for *mail delivery*, a purpose completely unrelated to – and incompatible with – the intended purpose of the primary reference.

Further, the modification suggested by the Examiner requires the type of "substantial reconstruction and redesign" that court in *In re Ratti* deemed an improper modification of the primary reference. The proposed modification entirely changes both the structure and purpose of the invention of Lambert. In particular, the proposed modification would result in a record keeping tray that would no longer resemble the inventive structure envisioned in Lambert, and have none of the functionality originally intended.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. The Manual of Patent Examining Procedure §2144.05, pg. 2100-152, 8th Edition, Revision 6 (2007); *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). As mentioned previously, the Supreme Court of the United States recently confirmed this principle, holding that "when the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007).

Pippin clearly teaches away from the modification proposed by the Examiner. In particular, Pippin teaches a mail case in which mail is sorted into individual bags, each representing a unique delivery point (e.g., col. 2, lines 23-25). The mail case is described as overcoming "significant problems" with traditional mail cases (col. 1, line 47). The problems described are that "dividers 21 between stops in existing USPS mail cases are relatively rigid, and they cannot be conveniently repositioned during a sort" (col. 1, lines 47-50). Indeed, Pippin states that "*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits

random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Lambert is directed to an a record keeping tray 10 having non-flexible dividers that cannot be repositioned. Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin *teaches away* from a mail sorting structure having non-flexible dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

ii. Independent Claim 9

The Office Action concedes that Lambert does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include each substantially vertical section has [sic] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the record keeping tray 10 of Lambert within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the record keeping tray 10 of Lambert to meet the limitations of claim 9.

1. *The Proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Lambert proposed in connection with claim 9 would render the invention of Lambert unsatisfactory for its intended purpose. First, as discussed above, the record keeping tray 10 is constructed to be a “convenient, compact” record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of the spaced dividers 13, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions.

Accordingly, the proposed modification would render the record keeping tray of Lambert unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed. Claims 10-13, 14-18 and 25 depend from independent claim 9 and are patentable over Lambert and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.*

The modification to Lambert proposed in connection with claim 9 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the dividers 13 of the record keeping tray 10 of Lambert, the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the record keeping tray of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having non-flexible dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

iii. Independent Claim 19

The Office Action concedes that Lambert does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin “wherein the base is sized to substantially cover

a bottom surface of the mail sorting bin” or “wherein each substantially vertical support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 19. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the record keeping tray of Lambert within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the record keeping tray of Lambert to meet the limitations of claim 19.

1. *The Proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Lambert proposed in connection with claim 19 would render the invention of Lambert unsatisfactory for its intended purpose. First, as discussed above, the record keeping tray 10 is constructed to be a “convenient, compact” record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of and otherwise re-dimensioning the spaced dividers 13, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions.

Accordingly, the proposed modification would render the record keeping tray of Lambert unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed. Claims 23 and 26 depend from

independent claim 19 and are patentable over Lambert and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.*

The modification to Lambert proposed in connection with claim 19 would change the principle of operation of the invention. In addition to proposing significantly re-dimensioning the dividers 13 of the record keeping tray 10 of Lambert, the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the dividers 13 of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 19, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having non-flexible dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

iv. Independent Claim 20

The Office Action concedes that Lambert does not disclose “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines... wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines and disposed within the mail sorting bin, the sheet forms a base and at least one upright support having a height of approximately 11 inches to support flat mail in an upright orientation,” as recited in claim 20. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Lambert to include the support having a height of approximately 11 inches, as taught by Pippin, for the purpose of fitting closely within existing letter trays use *[sic]* by the USPS.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below. As discussed below, there is simply no motivation to use the record keeping tray of Lambert within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the record keeping tray of Lambert to meet the limitations of claim 20.

1. *The Proposed Modification to Lambert Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Lambert proposed in connection with claim 20 would render the invention of Lambert unsatisfactory for its intended purpose. First, as discussed above, the record keeping tray 10 is constructed to be a “convenient, compact” record keeping tray. Modifying Lambert in the manner proposed would thwart these objectives, resulting in an unwieldy and impractical arrangement. Moreover, by increasing the height of the spaced dividers 13, the dividers could no longer occupy the box assembly 12, because they would exceed its dimensions.

Accordingly, the proposed modification would render the record keeping tray of Lambert unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed. Claims 21 and 27 depend from independent claim 20 and are patentable over Lambert and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Lambert Would Change the Principle of Operation of the Invention.*

The modification to Lambert proposed in connection with claim 20 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the dividers 13 of the record keeping tray 10 of Lambert, the Examiner proposed using the dividers 13 (in connection with the flats tub 50 of Pippin) for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the record keeping tray of Lambert, as well as a change in the basic principle (i.e., organizing canceled checks) under which the record keeping tray was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Lambert with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having non-flexible dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Lambert in view of Pippin is improper and should be reversed.

C. **Claims 1-13 and 15-27 are Patentable over Henig in view of Pippin**

Claims 1-13 and 15-27 (including independent claims 1, 9, 19 and 20) are not unpatentable under 35 U.S.C. §103(a) as being obvious over Henig (U.S. Patent No. 3,754,646) in view of Pippin (U.S. Patent No. 6,715,614).

i. Independent claim 1

The Office Action concedes that Henig does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin, “wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” or “wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 1. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery.

The Office Action provides no motivation whatsoever to modify Henig such that “at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” of Pippin. Applicants submit that this improper. A rational underpinning for a proposed modification must be provided. KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007).

Applicants disagree that there is any acceptable suggestion or motivation in the prior art to modify the teachings of Henig with the teachings of Pippin to achieve the claimed invention.

The primary reference, Henig, discloses a receptacle 1 used to receive and arrange letters of a single group (e.g., an address) dropped therein (col. 3, lines 19-32). In contrast, the primary secondary reference, Pippin, discloses a flats tub 50 used by the U.S. Postal Service for mail delivery to a plurality of addresses (col. 5, line 64 – col. 6, line 15). The receptacle 1 of the primary reference, Henig, and the flats tub 50 of the secondary reference, Pippin, are reproduced below.

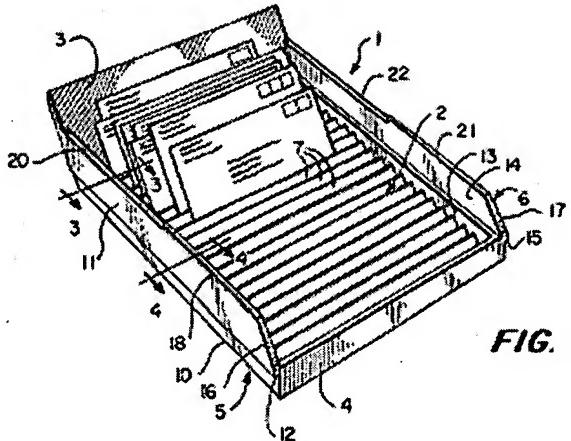


FIG. 1

Receptacle 1 of Henig (Fig. 1)

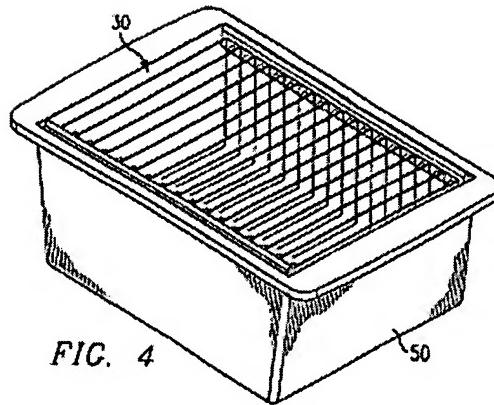


FIG. 4

Flats tub 50 of Pippin (Fig. 4)

As discussed below, there is simply no motivation to use the receptacle 1 of Henig with the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the receptacle 1 of Henig to meet the limitations of claim 1 (e.g., “a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” and “at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin”).

1. *The Proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.*

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The Manual of Patent Examining Procedure §2143.01, pg. 2100-140, 8<sup>th</sup> Edition, Revision 6 (2007); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In the present application, the Examiner’s proposed modification to Henig would render the invention of Henig unsatisfactory for its intended purpose. In particular, the Examiner proposes

modifying Henig “to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin... for the purposes of maintaining sequence order and facilitating delivery.” (Office Action at page 15, lines 10-14) The Examiner also apparently proposes modifying Henig to include “a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin” of Pippin, although no motivation is provided. Nevertheless, it is assumed such a modification is proposed, as Henig does not disclose or suggest this feature.

The primary reference, Henig, discloses a receptacle 1 used to receive and arrange letters of a single group (e.g., an address) dropped therein (col. 3, lines 19-32). The receptacle 1 of Henig has a corrugated bottom wall 2 forming notches 7, each of which is used to hold a single letter (col. 6, lines 1-11, col. 2, lines 23-27 and col. 4, lines 40-51). Letters collected in the receptacle are arranged automatically in a consistent orientation so as to be removable as a group or stack ready for banding or tying (col. 4, lines 60-63). To achieve this objective, the notches 7 receive only the lower edge of letters, such that the letters pivot backwards and rest on end wall 3 (col. 4, lines 40-44).

Modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group in a consistent orientation so that they may be removed *as a group or stack* ready for banding or tying. If the notches 7 of the corrugated bottom wall 2 were somehow resized to have a height approximating that of the flats tub 50 of Pippin, rather than the notches 7 receiving only the lower edge of letters as designed, the notches would far exceed (i.e., by more than double) the height of the letters. The receptacle 1 could no longer work as intended, such that letters pivot backwards and rest on end wall 3. Significantly, letters of a group could no longer be removed *as a group or stack*. Rather, each letter would need to be removed individually from its corresponding notch 7, resulting a receptacle 1 having no apparent utility. As in Gordon, discussed herein, wherein operating the liquid strainer device in an upside down orientation rendered the device inoperable to perform its intended function, modifying the receptacle 1 of Henig to meet the limitations of claim 1 would result in a receptacle with no practical utility.

Accordingly, because the proposed modification to Henig would render the receptacle 1 unsatisfactory for its intended purpose, there is no motivation to make such a modification. Therefore, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed. Claims 2-8, 22 and 24 depend from independent claim 1 and are patentable over Henig and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.*

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The Manual of Patent Examining Procedure §2143.01, pg. 2100-141, 8<sup>th</sup> Edition, Revision 6 (2007); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the present application, the Examiner proposes a modification to Henig that would change the principle of operation of the invention. The Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig... for the purposes of maintaining sequence order and facilitating delivery.” Thus, the Examiner suggests modifying Henig so that the receptacle 1 is disposed within the flats tub of Pippin and used for *mail delivery*. This purpose is completely incompatible with the intended purpose of the primary reference, which is to arrange letters of a *single* address.

Further, the modification suggested by the Examiner requires the type of “substantial reconstruction and redesign” that court in *In re Ratti* deemed an improper modification of the primary reference. The proposed modification entirely changes both the structure and purpose of the invention of Henig. In particular, the proposed modification would result in a receptacle that would no longer resemble the inventive structure envisioned in Henig, and have none of the functionality originally intended.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. The Manual of Patent Examining Procedure §2144.05, pg. 2100-152, 8th Edition, Revision 6 (2007); *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). As mentioned previously, the Supreme Court of the United States recently confirmed this principle, holding that “when the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007).

Pippin clearly teaches away from the modification proposed by the Examiner. In particular, Pippin teaches a mail case in which mail is sorted into individual bags, each representing a unique delivery point (e.g., col. 2, lines 23-25). The mail case is described as overcoming “significant problems” with traditional mail cases (col. 1, line 47). The problems described are that “dividers 21 between stops in existing USPS mail cases are relatively rigid, and they cannot be conveniently repositioned during a sort” (col. 1, lines 47-50). Indeed, Pippin states that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Henig is directed to a receptacle having non-compliant, non-flexible, rigid notches that cannot be repositioned. Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 1 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

ii. Independent Claim 9

The Office Action concedes that Henig does not disclose a mail sorting bin insert “wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin,” as recited in claim 9. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig to include each substantially vertical section has [sic] a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of storing and using the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the receptacle of Henig within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the receptacle of Henig to meet the limitations of claim 9.

1. *The Proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Henig proposed in connection with claim 9 would render the invention of Henig unsatisfactory for its intended purpose. As explained in connection with claim 1, modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group so that they may be removed *as a group or stack* ready for banding or tying. If the proposed modification were made, each letter would need to be removed individually from its corresponding notch 7, resulting a receptacle 1 having no apparent utility.

Accordingly, the proposed modification would render the receptacle of Henig unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore,

the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed. Claims 10-13, 15-18 and 25 depend from independent claim 9 and are patentable over Henig and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.*

The modification to Henig proposed in connection with claim 9 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the notches 7 of the receptacle 1 of Henig, the Examiner proposed using the receptacle for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the receptacle of Henig, as well as a change in the basic principle (i.e., arranging letters of a *single* address) under which the receptacle was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 9 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

iii. Independent Claim 19

The Office Action concedes that Henig does not disclose a mail sorting bin insert, constructed to be disposed within a mail sorting bin “wherein the base is sized to substantially cover a bottom surface of the mail sorting bin” or “wherein each substantially vertical support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin,” as recited in claim 19. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have modified Henig to include the support being constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin and dimensioning the insert such that it fits closely within letter trays used by the USPS, as taught by Pippin, for the purposes of maintaining sequence order and facilitating delivery and allowing storage and use of the insert with flats tubs or letter trays.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below.

As discussed below, there is simply no motivation to use the receptacle of Henig within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the receptacle of Henig to meet the limitations of claim 19.

1. *The Proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Henig proposed in connection with claim 19 would render the invention of Henig unsatisfactory for its intended purpose. As explained in connection with claim 1, modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group so that they may be removed *as a group or stack* ready for banding or tying. If the proposed modification were made, each letter would need to be removed individually from its corresponding notch 7, resulting a receptacle 1 having no apparent utility.

Accordingly, the proposed modification would render the receptacle of Henig unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed. Claims 23 and 26 depend from independent claim 19 and are patentable over Henig and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.*

The modification to Henig proposed in connection with claim 19 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the notches 7 of the receptacle 1 of Henig, the Examiner proposed using the receptacle for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the of Henig, as well as a change in the basic principle (i.e., arranging letters of a *single* address) under which the receptacle was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

4. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 19 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

iv. Independent Claim 20

The Office Action concedes that Henig does not disclose “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines... wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines and disposed within the mail sorting bin, the sheet forms a base and at least one upright support having a height of approximately 11 inches to support flat mail in an upright orientation,” as recited in claim 20. However, the Office Action states:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Henig to include the support having a height of approximately 11 inches when the insert is disposed within the mail sorting bin, as taught by Pippin, for the purpose of fitting closely within existing letter trays use *[sic]* by the USPS.

Applicants respectfully disagree that a person of ordinary skill in the art would have been so motivated for the reasons set forth below. As discussed below, there is simply no motivation to use the receptacle of Henig within the flats tub 50 of Pippin, as suggested in the Office Action, or to modify the receptacle of Henig to meet the limitations of claim 20.

Further, as discussed below, neither reference teaches "a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines," as recited in claim 20.

1. *The Proposed Modification to Henig Would Render the Invention Unsatisfactory for its Intended Purpose.*

The modification to Henig proposed in connection with claim 20 would render the invention of Henig unsatisfactory for its intended purpose. As explained in connection with claim 1, modifying the receptacle 1 of Henig in the manner suggested would entirely subvert the purpose of the receptacle, which is to arrange letters of a group so that they may be removed *as a group or stack* ready for banding or tying. If the proposed modification were made, each letter would need to be removed individually from its corresponding notch 7, resulting a receptacle 1 having no apparent utility.

Accordingly, the proposed modification would render the receptacle of Henig unsatisfactory for its intended purpose, and thus there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed. Claims 21 and 27 depend from independent claim 20 and are patentable over Henig and Pippin for at least the same reasons as the independent claim.

2. *The Proposed Modification to Henig Would Change the Principle of Operation of the Invention.*

The modification to Henig proposed in connection with claim 20 would change the principle of operation of the invention. In addition to proposing significantly increasing the height of the notches 7 of the receptacle 1 of Henig, the Examiner proposed using the receptacle for *mail delivery*. Accordingly, the suggested modification would require a substantial reconstruction and redesign of the receptacle of Henig, as well as a change in the basic principle (i.e., arranging letters of a *single* address) under which the receptacle was designed to operate.

Accordingly, there is no motivation to make such a modification. Therefore, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

3. *Pippin clearly teaches away from the modification proposed by the Examiner.*

In addition, as discussed in connection with claim 1, Pippin teaches away from the modification proposed by the Examiner. In particular, Pippin teaches that “*an essential principle of the invention* is the use of slot dividing walls made of flexible or compliant material which permits random overfilling of certain slots while maintaining the same overall slot density” (col. 4, lines 1-5, emphasis added). Pippin teaches that this design overcomes “significant problems” with traditional mail cases (col. 1, line 47). Accordingly, one would not have been motivated to combine Henig with Pippin, because Pippin clearly *teaches away* from a mail sorting structure having rigid or otherwise non-compliant dividers that cannot be conveniently repositioned during a sort.

Accordingly, for this additional reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

4. *Neither reference teaches the recited “flat sheet” including “predefined fold lines.”*

Further, neither reference teaches “a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines,” as recited in claim 20.

The Office Action cites col. 7, lines 10+ of Henig as allegedly disclosing this feature. However, Henig is completely respect with respect to any “*flat sheet*” or “*predefined fold lines*.”

If the Examiner believes these features are somehow inherent, he has not met the burden required to establish inherency. As set forth in MPEP § 2112: “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further as set forth in MPEP § 2112, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such technical reasoning has been provided.

Accordingly, for this additional reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

5. *No desirability of making the proposed modification is apparent.*

The mere fact that references *can* be modified does not render the resultant modification obvious unless the prior art also specifically suggests the desirability of the modification. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As should be appreciated from the foregoing, the proposed modification has no apparent desirability.

For this further reason, the rejection of independent claim 20 under 35 U.S.C. §103(a) as being obvious over Henig in view of Pippin is improper and should be reversed.

### VIII. Conclusion

In sum, the Examiner has failed to establish a *prima facie* case of obviousness with respect to all rejections. Accordingly, the rejections of the claims are improper and should be reversed.

Respectfully submitted,



Melissa A. Beede, Reg. No. 54,986  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210  
Tel (617) 720-3500  
Fax (617) 720-2441

Attorney Docket No.: L0562.70048US00

Dated: October 31, 2007

**IX. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))**

1. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a bottom defining a substantially planar surface having a length and a width, wherein at least one of the length and the width substantially corresponds to at least one of a length and width of the mail sorting bin; and

at least one support projecting upright from the bottom, wherein the support is sized and configured to support flat mail in a substantially vertical orientation, and wherein each support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.

2. (Original) The mail sorting bin insert of Claim 1, wherein the insert comprises a lightweight material.

3. (Original) The mail sorting bin insert of Claim 2, wherein the insert comprises a material selected from the group consisting of cardboard, plastic, wood, and composites.

4. (Original) The mail sorting bin insert of Claim 1, wherein the insert comprises two supports.

5. (Previously Presented) The mail sorting bin insert of Claim 4, wherein the bottom of the insert comprises three substantially coplanar sections which are separated from each other by the two supports, and wherein the two supports have substantially triangular-shaped cross sections.

6. (Original) The mail sorting bin insert of Claim 1, wherein the at least one support has a triangular-shaped cross section.

7. (Original) The mail sorting bin insert of Claim 1, wherein the bottom and at least one support are created from a single piece of material.

8. (Original) The mail sorting bin insert of Claim 7, wherein the at least one support is created by folding the single piece of material.

9. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising at least one substantially rigid substantially vertical section projecting from a substantially horizontal section, wherein the insert is sized and configured to receive flat mail from an automatic mail sorter, and wherein each substantially vertical section has a height of approximately 11 inches when the insert is disposed within the mail sorting bin.

10. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises a lightweight material.

11. (Original) The mail sorting bin insert of claim 10, wherein the lightweight material is selected from the group consisting of cardboard, plastic, wood, and composites.

12. (Original) The mail sorting bin insert of claim 9, wherein the insert has two substantially vertical sections.

13. (Original) The mail sorting bin insert of claim 9, wherein the at least one substantially vertical section has a substantially triangular-shaped cross section.

14. (Canceled)

15. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises a single piece of material.

16. (Original) The mail sorting bin insert of claim 15, wherein the insert is folded to create the substantially vertical sections and substantially horizontal sections.

17. (Previously Presented) The mail sorting bin insert of claim 9, wherein the height of each substantially vertical section approximates a height of the mail sorting bin.

18. (Original) The mail sorting bin insert of claim 9, wherein the insert comprises an anti-slip surface.

19. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a base defining a substantially planar surface, wherein the base is sized to substantially cover a bottom surface of the mail sorting bin; and

a plurality of substantially vertical supports attached to the base, wherein each substantially vertical support has a slope height and a triangular-shaped cross section sized and configured to support flat mail in a substantially vertical orientation, and wherein each substantially vertical support is constructed such that a maximum height of the support approximates a maximum height of the mail sorting bin.

20. (Previously Presented) A mail sorting bin insert, constructed to be disposed within a mail sorting bin, the insert comprising:

a flat sheet, wherein the flat sheet includes a plurality of sections and a plurality of predefined fold lines,

wherein two adjacent sections are separated by a predefined fold line,

wherein the predefined fold lines are arranged and configured such that when the flat sheet is folded at the predefined fold lines and disposed within the mail sorting bin, the sheet forms a base and at least one upright support having a height of approximately 11 inches to support flat mail in an upright orientation.

21. (Previously Presented) The mail sorting tub insert according to claim 20, wherein the flat sheet has an upper surface and a lower surface, and wherein at least one predefined fold line on the upper surface permits a first section to rotate with respect to an adjacent second section in one direction, and wherein at least one predefined fold line on the lower surface permits a third section to rotate with respect to an adjacent fourth section in the other direction.

22. (Previously Presented) The mail sorting bin insert of claim 1, wherein the mail sorting bin is approximately 11 inches high.

23. (Previously Presented) The mail sorting bin insert of claim 19, wherein each substantially vertical support of the at least one substantially vertical support has a height of approximately 11 inches.

24. (Previously Presented) The mail sorting bin insert of claim 1, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

25. (Previously Presented) The mail sorting bin insert of claim 9, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

26. (Previously Presented) The mail sorting bin insert of claim 19, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

27. (Previously Presented) The mail sorting bin insert of claim 20, wherein the mail sorting bin is approximately 12 inches wide, 15 inches long, and 11 inches deep.

**X. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))**

None

**XI. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))**

None